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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,062	02/04/2000	Paola Caracino	05788.0124	8277

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EXAMINER

NORRIS, JEREMY C

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/498,062

Applicant(s)

CARACINO ET AL.

Examiner

Jeremy C. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-43 is/are pending in the application.
- 4a) Of the above claim(s) 40 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27,30-33,37-39,41 and 43 is/are rejected.
- 7) ☒ Claim(s) 28,29 and 34-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 11/24/02 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of species b1 in Paper No. 0603 is acknowledged. The traversal is on the ground(s) that claim 27 is generic to all species. This is not found persuasive because while Examiner agrees that claim 27 is indeed generic, Applicants have submitted no reasoning for the species themselves are not patentably distinct. Therefore, the arguments amount to a mere allegation that the species are not patentably distinct. Examiner notes, however, that if a generic claim is deemed to be allowable, Applicants will be afforded the opportunity to rejoin those claims that contain all the limitations of the allowable generic claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 27, 30-33, 37 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,262,375 (hereafter Engelhardt).

Engelhardt discloses, referring to figure 3, a high temperature superconducting cable, comprising: a tubular support (105); and a plurality of superconducting tapes

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(125) spirally wound onto the tubular support to form at least an electroinsulated, thermally-insulated, and refrigeratable superconducting layer, wherein the superconducting tapes include a superconducting material (lead stabilized bismuth) enclosed in a metal covering (silver cladding); wherein the superconducting tapes comprise at least one metal strip (copper) coupled to the metal covering (see col. 6, lines 60-68 for complete disclosure) [claims 27, 31, 32, 33], wherein the metal covering comprises silver [claim 30], wherein the tubular support is made of metal (see col. 6, lines 50-60) [claim 37], wherein the tubular support has a spirally-wound metal strip structure (see col. 6, lines 55-60) [claim 41]

Specifically regarding claims 31-33, these claims present process limitations within the context of a process claim. These process limitations have been considered only to the extent which they impact the claimed product. Moreover, it is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art, cannot impart patentability to that product. (*In re Thorpe*, 227 USPQ 964, 966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt in view of US 4,549,156 (hereafter Mine).

Engelhardt discloses the claimed invention as described above with respect to claim 27, except Engelhardt does not specifically state that the tubular support is made of non-magnetic stainless steel. However, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to use non-magnetic stainless steel since it is a metal known to be employed as a former in a superconducting cable as evidenced by Mine (see col. 3, lines 1-20). Additionally, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt in view of US 5,932,523 (hereafter Fujikami).

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Engelhardt discloses the claimed invention as described above with respect to claim 27, except Engelhardt does not specifically state that the tubular support is made of copper. However, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to use copper since it is a metal known to be employed as a former in a superconducting cable as evidenced by Fujikami (see col. 4, lines 40-45). Additionally, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt in view of US 6,194,352 (hereafter Riley).

Engelhardt discloses the claimed invention as described above with respect to claim 27, except Engelhardt does not specifically state that the winding angle is smaller than 40 degrees. However, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to make the winding angle less than 40 degrees as it is a technique well known in the art. Evidence of this knowledge is present in Riley (see col. 17, lines 50-68). Moreover, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

Claims 28, 29, and 34-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 25 February 2002 have been fully considered but they are not persuasive. Applicants' arguments hinge on the contention that Engelhardt does not disclose a metal strip coupled to the metal covering of the superconducting tapes. In support of this contention, Applicants' discuss, at length, how various parts of the Engelhardt invention cannot possibly be analogous to Applicants' claimed metal strip coupled to the metal covering of the superconducting tapes. However, it appears to the Examiner that Applicants have failed to consider the very part of Engelhardt (tapes 125 in figure 3) which are analogous to Applicants claimed superconductor tapes. Since Engelhardt explicitly states that these tapes are comprised of superconducting material, encased in silver, with copper bonded to the silver (see col. 6, lines 60-65), Applicants contention otherwise is untenable and not persuasive to the Examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 703-306-5737. The examiner can normally be reached on Mon.-Th., 9AM - 6:30 PM and alt. Fri. 9AM-5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JCSN

John B. Vigushin
John B. Vigushin
Primary Examiner
AM 2827